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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/870,226	05/30/2001	Kenneth L. Smith	54538USA7C012	9179

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EXAMINER

LONEY, DONALD J

ART UNIT	PAPER NUMBER
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1772

DATE MAILED: 08/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/870,226

Applicant(s)

SMITH ET AL.

Examiner

Donald Loney

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 May 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) -21,35-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13,15-21 and 35-37 is/are rejected.
- 7) ☒ Claim(s) 14 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 02/14/05.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

3. Claims 15-18, 20, 21 and 35-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chau et al (5735988) in view of Stamm.

Chau et al. disclose a method for making a reflective (i.e. engineered reflective surface), article (column 9, lines 39-48). Chau et al. teach the method comprises providing a base layer, forming a structured surface on the base layer, applying a reflective coating to the structured surface, applying an at least partially transparent, flowable, and radiation curable adhesive (e.g. acrylic based) to the structured surface, placing a substrate over the radiation curable adhesive (see Figures IC-IF and column

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5, lines 57-65 and column 6, lines 1-19). Alternatively, Chau et al. teach applying the radiation curable adhesive by first coating the substrate and then, applying the coated substrate to the structured surface (column 6, lines 20-21). Chau et al. are silent as to the structured surface comprising retroreflective cube corner cavities. However, Chau et al. require a reflective surface topography, and Chau et al. specifically teach choosing the surface topography of the structured surface is well within the ordinary skill of one in the art (column 5, lines 14-21 and column 10, lines 1-5).

Stamm discloses a surface topography to produce retroreflective articles having high retroreflective efficiency. Stamm teaches forming a high efficiency retroreflective article by providing a base layer, forming a structured surface comprising cube corner cavities separated on their top surface on the base layer, applying a reflective foil to the structured surface, and filling the structured surface with an optically transparent material (see Figure I and the abstract and column 2, lines 3-13 and column 3, lines 35-55 and column 5, lines 8-14 and column 6, lines 38-45).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to Chau et al. to use the cube corner cavity surface topography, as taught by Stamm, for the topography of Chau et al. in order to create a cube corner cavity retroreflective article having high retroreflective efficiency motivated by the fact Chau et al. teaches other topographies can be used to form reflective articles and retroreflective articles are a type of reflective article.

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4. Claims 1-13 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chau et al in view of Stamm as applied to claims 15-18, 20, 21 and 35-37 above, and further in view of Rowland (3810804).

With regards to claims 1 and 19, Chau et al. and Stamm as applied above teach all of the limitations in claims 1 and 19 except for specifically reciting the radiation curable adhesive is pressure-sensitive. However, one of ordinary skill in the art at the time the invention was made would have readily appreciated that acrylic based radiation curable adhesive such as that taught by Chau et al. in view of Stamm above, is pressure-sensitive as evidenced by Rowland wherein the pressure sensitive properties of an acrylic based adhesive are noted in the same environment. Rowland discloses a method for making a retroreflective article. Rowland teaches the method comprises providing a base layer having a structured surface, applying a reflective coating to the structured surface, applying a flowable, acrylic pressure-sensitive adhesive to the structured surface, and laminating a releasable sheet to the structured surface. Rowland further teaches removing the releasable sheet to mount the reflective material on a surface (Figure 3 and column 4, lines 42-50 and column 7, lines 63-70 and 74-75 and column 8, lines 1-2 and the Examples). With regards to claims 6-8, Chau et al. and Stamm as applied above teach all of the limitations except for a specific teaching of using a releasable liner as the substrate. However, Chau et al. are not limited to any particular type of substrate, and Chau et al. are not limited to any particular retroreflective article. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use as the substrate taught by Chau et al. as

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modified by Stamm a releasable liner as suggested by Rowland as it was conventional in the art to form the retroreflective article on a releasable liner substrate when the retroreflective article is not permanently mounted during its production such that it may be applied later to a final substrate. It would also be obvious to use a heat-activated adhesive as in claim 3 for the same reasons as a pressure sensitive adhesive is used (i.e. to mount the article).

5. Claims 1-13, 15-21 and 35-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over either Rowland (5376431) or Rowland (3810804) in view of Stamm.

Both primary references teach a retroreflective article comprising cube corner prisms coated with a reflective layer that has an adhesive there over. Refer to figure 3 in Rowland '804 showing prisms 12, reflective layer 30 and adhesive layer 32. Refer to figure 5 in Rowland '431 showing prisms 12, reflective layer 14 and adhesive layer 20. The primary references differ from the recited invention in that the prisms are considered a positive array (i.e. protrude outwardly) instead of a negative array (i.e. form cavities as recited in the instant claims). This is done so that light that enters through the back side (i.e. side opposite the adhesive or flowable material) is reflected back there through. The applicants invention is in forming the cube corners as cavities in the front side then applying a reflective film and adhesive thereto so that the article can be mounted from the front side and light can pass through the side with the adhesive and be reflected. It would appear this would be used to mount to a transparent substrate.

Stamm teaches that an array of cube corner elements can be in either cavity or prism form, then coated reflective material and filled in with a transparent medium in order to form an optical element having high reflective efficiency. Refer to column 2, lines 1-12, column 3, lines 34-65, column 4, lines 12-22, column 5, lines 8-15, column 6, lines 38-47, column 24, lines 1-38 and specifically column 25, lines 12-22 which disclose the alternative of the cavities or prism cube corner elements.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to either primary reference to form the cube corner elements as a cavity, as taught by Stamm, in order for light to be able to pass through the adhesive side of the article when used and be reflected therefrom motivated by the fact that Stamm teaches either prisms or cavities are known cube corner elements. The elastic modulus of claims 10 and 11 would be obvious to one of ordinary skill in the art motivated by the fact that the structure has been shown to be known and similar materials are used in the prior art and one would conform properties of an article to its particular application.

Allowable Subject Matter

6. Claim 14 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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7. The following is a statement of reasons for the indication of allowable subject matter: The prior art fails to teach, or suggest, a second pressure sensitive adhesive layer on the rear surface as recited.

Response to Arguments

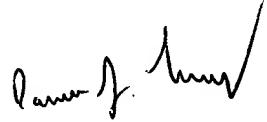
8. Applicant's arguments filed May 6, 2005 have been fully considered but they are not persuasive. The applicant argues that Chau et al fails to teach retroreflective articles. Chau et al does teach reflective articles, of which retroreflective articles are a specific type thereof. The examiner has made a new rejection based thereon above. The applicant argues the direction of the light passing through Rowland. However, the structure of the combination of the references would be equivalent to the structure recited by the applicant (i.e., cube corner cavities on a surface thereof). The applicant also argues the cover layer of claim 7 is not taught by the prior art, however, the prior art does teach a release liner (instant claim 6) of which the applicant on page 10, line 18-page 11, line 11 discloses are one in the same. The applicant also argues the modulus of elasticity of claims 10 and 11, however, the examiner deems this as obvious as explained above.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald Loney whose telephone number is (571) 272-1493. The examiner can normally be reached on Mon, Tues, Thurs and Fri. 8AM-4PM, flex schedule.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on 571 272-1498. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Donald Loney
Primary Examiner
Art Unit 1772

DJL:D.Loney
08/16/05